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EXAMINER

HAAS, WENDY C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Rule 105 Requirement for Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, the claimed plant variety, 'Penlava', was publicly available prior to the filing date of the instant application.

The claimed *Pelargonium* plant 'Penlava' is described in Plant Breeder's Right (PBR) grant number 7048, published June 15, 2001 and filed as application number 19981665, which was published February 15, 1999, more than one year prior to the effective filing date of the instant application. The information is published by the CPVO in the Official Gazette and is a form of public notice. Thus, the public was aware of the instant plant more than one-year prior to the filing date of this instant application.

Given this information, the application is a printed publication under the guidelines set forth in *In re Wyer*. See *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128. The Plant Breeder's Right application is enabled if the disclosed cultivar could have been propagated from publicly available materials. One skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929,133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.").

The publication cited above discloses the claimed variety. However, a question remains as to the accessibility of any foreign sales of the claimed plant, the reproducibility of the claimed plant and whether one of ordinary skill in the art would have known of any foreign sale. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. One of ordinary skill in the art would have known where to obtain the claimed plant. For example, by searching the Internet (specifiaally Yahoo!) for the UPOV listed applicant "ELSNER pac Jungpflanzen" one could have easily obtained the following contact information listed on the first web site "hit" listed in the search results

<http://www.pac-elsner.com/> as Kipsdorfer Strasse 146 D-01279 Dresden, Phone +49(0)351-255 91-0, Fax: +49(0)351 - 251 74 94 and e-mail info@pac-elsner.com

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With the contact information, one of ordinary skill in the art could check the availability of the claimed plant and where to purchase that plant.

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine the accessibility of any foreign sales or public availability and the reproducibility of any plants that were sold or made available to the public, more than one year prior to the effective filing date of this application.

In response to this requirement please provide:

- a) Information regarding all sales or public distribution of the claimed plant variety made more than one year prior to the effective filing date of the instant application **anywhere in the world**, including the date(s) and location of any sale or other public distribution including any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety that occurred more than one year prior to the effective filing date of this application, including information pertaining to whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art;
- b) a copy of the application, published application, published proposed denomination and published Plant Breeder's Right grant that is more than one year prior to the effective filing date of the instant application;
- c) a copy of all publications or advertisements known to applicant relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred more than one year prior to the effective filing date of this application;
- d) any information relating to the accessibility or non-accessibility of the claimed plant that one of ordinary skill in the art could have derived from the printed PBR document or other sources;
- f) Applicant is invited to submit any information that would indicate that one of ordinary skill in the art would not have known how to successfully reproduce the plant.

The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

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The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot be readily obtained will be accepted as a complete response to the requirement for that item.

The time period for reply to this requirement is 2 months. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

W. C. Haas
Patent Examiner
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KENT BELL
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Kent D. Bell".